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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,060	04/15/2002	Olga Bandman	PF-0683 USN	4673

7590

03/26/2003

Legal Department  
Incyte Genomics  
3160 Porter Drive  
Palo Alto, CA 94304

EXAMINER

PROUTY, REBECCA E

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/937,060

Applicant(s)

Bandman et al.

Examiner

Rebecca Prouty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-22 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 2, 15 and 16, drawn to an HRIP polypeptide and method of use.

Group II, claim(s) 3-6, 8, 10, and 11, drawn to polynucleotides encoding an HRIP protein.

Group III, claim(s) 7, drawn to a transgenic organism.

Group IV, claim(s) 9, drawn to antibodies to an HRIP protein.

Group V, claim(s) 12-14, drawn to methods of detecting a polynucleotide encoding an HRIP protein.

Group VI, claim(s) 17, drawn to methods of screening for an agonist of an HRIP protein.

Group VII, claim(s) 18, drawn to a composition comprising an agonist of an HRIP protein.

Group VIII, claim(s) 19, drawn to methods of treating with an agonist of an HRIP protein.

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Group IX, claim(s) 20, drawn to methods of screening for an antagonist of an HRIP protein.

Group X, claim(s) 21, drawn to a composition comprising an antagonist of an HRIP protein.

Group XI, claim(s) 22, drawn to methods of treating with an antagonist of an HRIP protein.

Group XII, claim(s) 23, drawn to methods of screening for an modulator of expression of an HRIP polynucleotide.

For each of inventions I-XII above, restriction to one of the following is also required under 35 USC 121 and 372. Therefore, election is required of one of inventions I-XII and one of inventions (A) - (N).

(A). protein of SEQ ID No: 15 or a nucleic acid encoding SEQ ID No: 15.

(B). protein of SEQ ID No: 16 or a nucleic acid encoding SEQ ID No: 16.

(C). protein of SEQ ID No: 17 or a nucleic acid encoding SEQ ID No: 17.

(D). protein of SEQ ID No: 18 or a nucleic acid encoding SEQ ID No: 18.

(E). protein of SEQ ID No: 19 or a nucleic acid encoding SEQ ID No: 19.

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(F). protein of SEQ ID No: 20 or a nucleic acid encoding SEQ ID No: 20.

(G). protein of SEQ ID No: 21 or a nucleic acid encoding SEQ ID No: 21.

(H). protein of SEQ ID No: 22 or a nucleic acid encoding SEQ ID No: 22.

(I). protein of SEQ ID No: 23 or a nucleic acid encoding SEQ ID No: 23.

(J). protein of SEQ ID No: 24 or a nucleic acid encoding SEQ ID No: 24.

(K). protein of SEQ ID No: 25 or a nucleic acid encoding SEQ ID No: 25.

(L). protein of SEQ ID No: 26 or a nucleic acid encoding SEQ ID No: 26.

(M). protein of SEQ ID No: 27 or a nucleic acid encoding SEQ ID No: 27.

(N). protein of SEQ ID No: 28 or a nucleic acid encoding SEQ ID No: 28.

The inventions listed as Groups I(A)-XI(N) do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The proteins as claimed in Groups I(A)-I(N), polynucleotides of Groups II(A)-

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II(N), transgenic organisms of groups III(A)-III(N), antibodies of Groups IV(A)-IV(N), agonists of Groups VII(A)-VII(N) and antagonists of Groups X(A)-X(N) are each unrelated and chemically distinct entities. Furthermore, the proteins of Group I(A)-I(N) do not share unity with the polynucleotides of Groups II(A)-II(N), respectively, as the proteins of groups I(A)-I(N) do not constitute a "special technical feature" as defined by PCT Rule 13.2, as they do not claim a feature which defines a contribution over the prior art as a protein within Groups I(A)-I(N) is taught by Groom et al. and Ruben et al. (WO 98/39466). The methods of Groups V(A)-V(N), VIII(A)-VIII(N), XI(A)-XI(N) and XII(A)-XII(N) do not share any technical feature with Groups I(A)-I(N) as the proteins of Groups I(A)-I(N) are neither made nor used by the methods of Groups V(A)-V(N), VIII(A)-VIII(N), XI(A)-XI(N) and XII(A)-XII(N). The methods of Groups VI(A)-VI(N) and IX(A)-IX(N) do not have unity of invention with Groups I(A)-I(N) as Groups I(A)-I(N) already include a method of use of the HRIP protein which comprises unrelated steps to the methods of Groups VI(A)-VI(N) and IX(A)-IX(N) and 37 CFR 1.475 does not provide for the inclusion of multiple methods of use within the main invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca Prouty, Ph.D. whose telephone number is (703) 308-4000. The examiner can normally be reached on Monday-Friday from 8:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached at (703) 308-3804. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Rebecca Prouty  
Primary Examiner  
Art Unit 1652